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Appeal No. 93-0363

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HEARD:

January 11, 1993

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Anthony Maglica

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Application for Design Patent filed September 22, 1989, Serial No. 411,576, a Division of Serial No. 356,361 filed May 3, 1989, which is a Continuation of Serial No. 222,378 filed July 19, 1988, which is a Continuation of Serial No. 34,918 filed April 6, 1987, now abandoned, which is a Continuation of Serial No. 828,729 filed February 11, 1986, now U.S. Patent No. 4,658,336, which is a Continuation of Serial No. 648,032 filed September 6, 1984, now U.S. Patent No. 4,577,263. Miniature Flashlight.

Robert C. Weiss for appellant.

Primary Examiner - Susan J. Lucas.
Examiner - Melanie H. Tung.

Before McCandlish, Parsons and Lyddane, Examiners-in-Chief.

McCandlish, Examiner-in-Chief.

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This appeal is from the examiner's rejection of the following design claim under 35 USC 103 and 35 USC 112 ¶ 1:¹

The ornamental design for a miniature flashlight as shown and described.

The claimed design in the subject application relates to the flashlight configuration shown in Figure 8 of appellant's first filed utility application Serial No. 648,032, which issued as U.S. Patent No. 4,577,263. The configuration shown in Figures 1 through 3 of utility application Serial No. 648,032 is the subject of appellant's companion, copending design application Serial No. 410,965. An appeal in that design application resulted in an affirmance of the examiner's rejection under 35 USC 103 and the entry of new grounds of rejection pursuant to 37 CFR 1.196(b). Attached as Appendix I are photocopies of the sheets of drawings as originally filed in appellant's utility application Serial No. 648,032.

¹ A copy of the claim on appeal is found on page 2 of the examiner's answer (Paper No. 21).

In rejecting the claim in the instant application, the examiner relies upon the following references:

Maglica ²	4,658,336	Apr. 14, 1987 (filed Feb. 11, 1986)
Huang	4,750,095	June 7, 1988 (filed Aug. 11, 1986)

The appealed claim stands rejected under 35 USC 103 as being unpatentable over the Maglica Patent No. 4,658,336 in view of the Huang patent. The appealed claim also stands rejected under the first paragraph of 35 USC 112 "for new matter" (answer, page 4).

Considering first the § 103 rejection, the examiner considers that Huang would have made it obvious to provide the flashlight head of the '336 Maglica patent with a rounded shape. Reference is made to the examiner's answer for further details of this rejection.

Appellant does not dispute that the applied references establish a prima facie case of obviousness. Instead, appellant contends that the patents relied upon in the § 103 rejection do

² This is appellant's own patent which issued on appellant's second filed utility application Serial No. 828,729 which is stated to be a continuation of appellant's above-mentioned utility application Serial No. 648,032. As far as we can see, the examiner has not stated any reasons for preferring to rely upon this patent rather than Patent No. 4,577,263 which issued on utility application Serial No. 648,032.

not qualify as prior art because appellant is entitled under the provisions of 35 USC 120 to the benefit of the filing date of appellant's above-mentioned utility application Serial No. 648,032, that filing date being earlier than the effective dates of the Maglica and Huang patents. In his brief, appellant has additionally alleged commercial success (see main brief, pages 3 and 4), but interestingly enough does not seem to explicitly assert the alleged commercial success as evidence of nonobviousness for rebutting the examiner's prima facie case of obviousness.

Since appellant does not otherwise question the § 103 rejection of the appealed claim if the instant design application is not accorded the benefit of the filing date of appellant's utility application Serial No. 648,032, a detailed analysis of the applied patents with regard to the obviousness issue is not necessary. See In re Ahlbrecht, 435 F.2d 908, 168 USPQ 293 (CCPA 1971).

The examiner has refused to accord the instant application the benefit of any of appellant's preceding utility applications, including application Serial No. 648,032, on the ground that the design disclosed in utility application Serial No. 648,032 is not the same as the design now claimed in the instant application. In particular, the examiner focuses on what she asserted to be a difference in the profile of the flashlight

heads shown in the drawings of the instant application and the drawings in the utility application Serial No. 648,032.

Although a new sheet of drawings was filed and entered in the instant application after the final Office action (Paper No. 12 mailed July 18, 1991), the examiner's remarks in the final Office action are nevertheless applicable to the drawings currently pending in the instant application:

Applicant asserts that the original Fig. 8 flashlight does not show a contour which describes a definite change in plane. The examiner agrees that a specific contour line indicating a change in plane is not shown in Fig. 8, but this is simply and obviously because the portion where it would be seen is cut-away. It remains the examiners [sic, examiner's] position that Fig. 8 does show a flashlight head with a definite change in plane, as seen from the cut-away view. (Note A on the attached photoprints.) In addition, the incomplete drawing of Fig. 8 necessitates a reliance on the other figure views, namely, Figs. 2 and 3 for a complete disclosure. These two views do show a flashlight head with a distinct change in plane, contrary to the assertion by the applicant that Figs. 2 and 3 show rounded heads. (Note B.) [emphasis in the original, final Office action, pages 2 and 3]

With further regard to the shape of the flashlight head, the examiner added the following remarks on page 10 of the answer:

The understanding that a flashlight head shape is critical to the nature of the flashlight as a whole is manifested in

appellant's own reluctance to correct the drawings as described by the examiner (which would ensure the benefit of priority) - the addition of a contour line and shading describing this distinct change in plane on the head. [emphasis added]

The "contour line" mentioned in the immediately preceding quotation from page 10 of the examiner's answer is in reference to the parting line shown at the juncture between the cylindrical and tapered portions of the flashlight head in Figure 1 of the utility application drawings (see Appendix I). We have identified this contour line or parting line, as it also may be called, by the reference character Bd 1 in the photocopy containing Figure 1 in Appendix I. On this photocopy in Appendix I, we have also marked the cylindrical portion of the flashlight head as Bd 2 and the rearward tapered portion of the head as Bd 3.

In response to the examiner's position as quoted supra, appellant argues as follows:

Sworn testimony and technical data have been submitted by the Appellant to demonstrate that the shape or profile of the head of the flashlight in the present [sic] formal drawings is the same as the shape or profile of the head of the flashlight shown in Figures 2 and 3 of the original drawings. (See the declaration of Fred R. McAlister filed December 23, 1991 and attached other declarations of Mr. McAlister). The Examiner has not demonstrated in any objective fashion that the shape or profile of the head of the

flashlight in the present formal drawings is different from the shape or profile of the head of the flashlight in Figures 2 and 3 of the original drawings.

The difficulty with this case is that without directly saying it, the Examiner is attempting to restrict Appellant's invention to a flashlight with a head which conforms to that shown in Figure 1 of the original drawings. It has been the Examiner's position during the prosecution of the present application that the head of the flashlight must have an angled profile in order to be entitled to the benefit of continuity from the original parent utility application, Serial No. 648,032. The only figure in the original drawings which supports this position is Figure 1. Figures 2 and 3 do not reflect an angled profile.

As set forth in the Supplemental Response and accompanying declarations of Fred R. McAlister and Anthony Maglica filed December 23, 1991, Figure 1 of the original drawings involves an error by the draftsperson. This error created an inconsistency between Figure 1 and Figures 2 and 3 of the original drawings. [main brief, pages 6 and 7]

Appellant contends on page 8 of the main brief that because the asserted inconsistencies in the utility application drawings are drafting errors, they do not constitute a sufficient basis for refusing to accord the instant design application the benefit of the filing date of utility application Serial No. 648,032. In support of this argument, appellant mainly relies upon Ex parte Asano, 201 USPQ 315 (Bd. App. 1978).

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Although it is apparent from the foregoing that the debate between the examiner and appellant centers on the shape of the flashlight head, other distinctions exist between the design shown in the drawings now pending in the instant application and the flashlight illustrated in Figure 8 of the drawings in utility application Serial No. 648,032 as will be discussed infra.

We have carefully considered the record before us including the evidence proffered by appellant together with appellant's arguments. However, we conclude that the § 103 rejection of the appealed claim is sustainable. Our reasons for this holding follow.

There is no dispute that where the requirements of 35 USC 120 are satisfied, an application for a design patent filed as a division of an earlier filed application for a utility patent is entitled to the benefit of the earlier filing date of the utility application. See Racing Strollers Inc. v. TRI Industries Inc., 878 F.2d 1418, 11 USPQ2d 1300 (Fed. Cir. 1989).

In the present case, the instant design application was filed as a continuation of appellant's utility application Serial No. 356,361 under 37 CFR 1.60. As a result of an amendment, however, the instant application is now stated to be a division of the earlier filed utility application Serial No. 356,361.

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Utility application Serial No. 356,361, as evidenced from the caption on the first page of this decision, is the last of a long series of ancestor utility applications of overlapping copendency, commencing with the above-mentioned utility application Serial No. 648,032.

One requirement for obtaining the benefit of the filing date of the first filed utility application is that the invention now claimed must be disclosed in the series of preceding utility applications, including the first filed application Serial No. 648,032. See In re Lukach, 442 F.2d 967, 169 USPQ 795 (CCPA 1971).

In the present case, the design now claimed is represented by one sheet of drawings containing Figures 1 through 4 filed on January 7, 1992 after the final Office action, which is dated July 18, 1991. The examiner has expressly indicated that this new sheet of drawings was entered in place of the drawings then pending in the instant application. See page 4 of the answer and the advisory Office action (Paper No. 16) mailed February 6, 1992.

The content of the drawings, of course, is of paramount importance in a design application because, unlike the usual utility application, the drawings in a design application represent the claimed subject matter in view of the recitation in the claim that the invention is an ornamental design as shown and

described. A change in the design application drawings, therefore, constitutes a change in the claimed design even when the wording of the claim remains unchanged.

Thus, to leave no doubt as to the design presently claimed, we have attached as Appendix II a photocopy of the single sheet of drawings presently in the application as filed on January 7, 1992. The sheet of drawings filed January 7, 1992 replaced a single sheet of drawings filed with a letter on May 29, 1991 which, in turn, replaced a single sheet of original drawings filed as part of the instant design application on September 22, 1989. We have attached a photocopy of the single sheet of original drawings filed with the application in Appendix III. The original drawings filed with the instant design application are of importance with regard to the examiner's rejection under § 112 ¶ 1.

In considering the requirement discussed supra for obtaining the benefit of the filing date of the first filed utility application, the court in In re Lukach, supra, stated:

One requirement for obtaining that benefit [of the filing date of the earlier application] is that the invention now claimed has to have been disclosed in both the parent and grandparent applications "in the manner provided by the first paragraph of section 112." (Id. at 169 USPQ at 796)

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See also In re Scheiber, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). and Racing Strollers Inc. v. TRI Industries Inc., supra. With regard to meeting the requirements of § 112, the court in Racing Strollers stated as follows:

As a practical matter, meeting the remaining requirements of §112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein by the prescribed formal claim. (Id. at 11 USPQ2d at 1301)

In In re Salmon, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983), the court characterized the test for compliance with § 120 in a design application situation as follows:

Insofar as here pertinent, these two provisions together require that for section 120 to apply, the first application must disclose "the invention" claimed in the second application. With respect to the design patent involved in this case, those provisions require that the stool design claimed in the second application must be the same design disclosed in the parent application. (Id. at 217 USPQ at 983) (Citations omitted)

Applying the foregoing principles to the present case, the series of appellant's prior art utility applications commencing with the first filed application Serial No. 648,032 and extending up to the last filed utility application Serial No.

356,361 must disclose the same design now claimed in the instant application.

As noted supra, it is appellant's position that "the shape or profile of the head of the flashlight in the present formal drawings is the same as the shape or profile of the head of the flashlight shown in Figures 2 and 3 of the original drawings [in the '032 utility application]" (main brief, page 6). It is also appellant's position that Figures 2 and 3 in the '032 utility application drawings (see our Appendix I) do not reflect an angled profile (i.e., a sharp juncture between the cylindrical and tapered flashlight head portions Bd 2 and Bd 3) and that the more sharply angled profile with the parting line (Bd 1) in Figure 1 of the '032 utility application drawings is the result of a draftsman's error. In support of these positions, appellant relies upon the McAlister declaration filed December 23, 1991, "attached other declarations of Mr. McAlister" (main brief, pages 6 and 7) and the Maglica declaration.

The McAlister declaration filed December 23, 1991 was executed on December 16, 1991 and was accompanied by copies of three additional McAlister declarations executed on February 28, 1991, May 28, 1991 and November 21, 1991, respectively. The originals of these last three McAlister declarations were filed in appellant's companion design application Serial No. 410,965. In addition to reaffirming the statements made in the three

accompanying declarations (executed on February 8, 1991, May 28, 1991 and November 21, 1991, respectively), the McAlister declaration filed December 23, 1991 and executed on December 16, 1991 states:

3. The shape of the head of the flashlight shown in the present formal drawings was generated by the method described in my May 28, 1991 declaration and the shape of the head in the present formal drawings is the same shape as the flashlight head shown in the formal drawings of U.S. Design Patent Application, Serial No. 410,965, and the same shape as the flashlight head shown in Figures 2 and 3 of the original drawings which I understand were submitted on September 6, 1984 to the Patent Office as part of the application Serial No. 648,032, now U.S. Patent No. 4,577,263. [McAlister declaration executed on December 16, 1991, paragraph 3]

The first difficulty with the McAlister declarations is that they were all filed in the instant design application prior to the date on which the pending design drawings were filed. Therefore, the reference in the McAlister declarations, particularly the declaration executed on December 16, 1991, to "the present formal drawings" is not to the currently pending drawings but to drawings no longer pending in the application. In any event, we will consider the McAlister declarations to the extent that they may be applicable to the currently pending design application drawings (see our Appendix II).

In our review of the evidence filed and relied upon in appellant's companion design application Serial No. 410,965, we made numerous findings and conclusions in the appeal involving the companion design application. Based upon our analysis of the evidence, we found that although the juncture between the cylindrical and tapered flashlight head portions Bd 2 and Bd 3 in Figures 2 and 3 of the original '032 utility patent application drawings did not define a pointed corner, the juncture was nevertheless sharp enough when viewed from the normal size of the utility application drawings to conclude that it was not inconsistent or a draftsman's error to add the parting line Bd 1 to Figure 1 of the original utility patent application drawings. Reference is made to our decision and accompanying appendices in appellant's companion design application Serial No. 410,965. A copy of this decision and the appendices have been attached hereto as Appendix IV.

In view of the correspondence of issues and evidence, we adopt and incorporate by reference our findings and conclusions set forth in our decision in appellant's companion design application Serial No. 410,965. It is clear that our findings and conclusions concerning the McAlister declaration of November 21, 1991 in appellant's companion design application are applicable here.

The remaining McAlister declarations are entitled to little probative weight for several reasons. First, the declaration executed February 8, 1991 merely states that the declarant duplicated the profile of the flashlight head shown in Figure 2 of the original '032 utility application drawings for the purpose of preparing drawings in appellant's companion design application Serial No. 410,965. This declaration further merely states that the data generated in the duplication process reproduced the same head profile in Figure 2 of the original drawings in the '032 utility patent application, but in a size shown in the Figures of the drawings then apparently pending in the companion design application Serial No. 410,965. No comparison, however, has been made between the computer aided reproduction and the shape of the flashlight head shown in the presently pending drawings in the instant application.

The significance of the McAlister declaration executed May 28, 1991 is questioned. Although declarant states that he repeated the steps of duplicating the profile of the flashlight head shown in Figure 2 of the original '032 utility patent application drawings using smaller increments for the plotted points, no conclusions were reached and no comparisons were made other than stating that the data generated were employed to reproduce the same head profile of Figure 2 in the original '032 utility patent application drawings, but in a size shown in the

Figures of the drawings then pending in the companion design application Serial No. 410,965.

Admittedly, the McAlister declaration executed on December 16, 1991 states that the shape of the flashlight head shown in the drawings then pending in the instant application at the time the declaration was executed was generated by the method described in the declarant's declaration of May 28, 1991. This declaration also states that the shape of the flashlight head in the drawings that existed as of December 16, 1991 is the same as the shape of the flashlight head shown in Figures 2 and 3 of the original '032 utility patent application drawings. We are not told, however, how the declarant acquired this information.

In this regard, there is no statement in the McAlister declaration executed on December 16, 1991 that the declarant participated in any way in the preparation of any of the drawings that were filed in the instant application. More importantly, there is nothing in the record before us to indicate that the statement in paragraph 3 of the McAlister declaration executed on December 16, 1991 was the result of the declarant's first hand knowledge. Thus, for all the record shows, the statements in paragraph 3 of the McAlister declaration executed on December 16, 1991 concerning the shape of the flashlight head in the instant application amount to hearsay. As such, these statements would

be entitled to little weight. See In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973).

In any event, it was our finding in appellant's companion design application Serial No. 410,965 and it is our finding in the instant application that although the juncture between the cylindrical and tapered head portions Bd 2 and Bd 3 in Figures 2 and 3 of the original utility application drawings (Appendix I) does not define a pointed corner, the juncture is nevertheless sharp enough when viewed from the normal size of the drawings to conclude that it was not inconsistent or a draftsman's error to add the parting line Bd 1 in the perspective view of Figure 1 of the drawings as originally filed in the '032 utility application.

The Maglica declaration executed on August 9, 1991 and filed in appellant's companion design application is also lacking in probative weight. Even if the draftsman did make a mistake in copying the shape of the flashlight head from whatever drawings or other materials that may have been supplied to him, that in itself does not excuse appellant from compliance with the statute, specifically the requirements in the first paragraph of 35 USC 112. Certainly, appellant has cited no authority to support such a proposition. The Weiss declarations are not probative inasmuch as they relate to changes made in details in

the design illustrated in appellant's companion design application.

Furthermore, appellant would seemingly have us ignore the showing in Figure 8 of the original utility application drawings despite the fact that the configuration shown in Figure 8 is the subject of the design claimed in the instant application. Figure 8 is significant, for it shows a relatively sharp juncture between the cylindrical and tapered portions of the flashlight head.

In view of the foregoing, we conclude that neither the first filed utility application Serial No. 648,032 nor any of the subsequently filed utility applications in the chain of utility applications support the elimination of the parting line Bd 1 in the flashlight head. This difference is not the type of a minor draftsman's error or imperfection that would be correctable under Ex parte Asano, supra, without adding new matter. Furthermore, Asano is not applicable to new matter issues (i.e., issues pertaining to the description requirement in the first paragraph of § 112) because the rejection there dealt with the enablement requirement in that paragraph and with the second paragraph of § 112.

In addition to the foregoing, there are additional design features shown in the presently pending design application drawings (see our Appendix II) which are not disclosed in either

the first filed utility patent application Serial No. 648,032 or any of the other utility patent applications in the copendency chain.

The first feature deals with the end wall configuration at the bulb end of the flashlight housing. As shown in Figures 5 and 8 of the utility application drawings (see our Appendix I), this end wall configuration is defined by a circular disc or end flange portion which forms a part of an insulator receptacle 47. We have marked this end disc or flange portion by the reference character Bd 5 in Figures 5 and 8 in our Appendix I.

The end disc portion Bd 5 is formed with a central, shallow recess which we have marked by the reference character Bd 6 in Figures 5 and 8 in our Appendix I. The recess Bd 6 has a bottom wall which we have marked by the reference character Bd 7 in Figures 5 and 8 of our Appendix I.

As viewed from Figure 8, the flashlight bulb 45 is shown to extend upwardly from bottom wall Bd 7. The recess Bd 6 is sufficiently shallow in depth so that the bottom end of bulb 45 at bottom wall Bd 6 can be seen from Figure 8.

In contrast to the foregoing configuration of the end disc portion Bd 5 for the insulator receptacle 47 in Figures 5 and 8 of the utility patent application drawings, the end disc or flange configuration shown in Figures 1 through 3 in the currently pending design application drawings (see our Appendix

II) has been significantly modified. In Figures 1 through 3 of the currently pending design application drawings, we have marked the flashlight housing end disc or end flange portion by the reference character Bd 5a. We have also applied the reference numeral 45 to identify the flashlight bulb in Figures 1 through 3 of the pending design application drawings.

As compared with the shallow recess Bd 6 in the utility application drawings, the end disc portion Bd 5a in the design application drawings seems to have an aperture or deep well which we have marked by the reference character Bd 6a.

Well Bd 6a does not appear to have a bottom wall inasmuch as the bottom end of the bulb 45 cannot be seen as it is seen in Figure 8 of the utility application drawings. This, incidentally, is what the examiner was referring to in subparagraph (a) on page 11 of the answer. It is apparent that there is a typographical error in this paragraph in that the word "covered" in the phrase "completely covered light" should read "uncovered".

Furthermore, the diameter of the central aperture Bd 6a relative to the outer diameter of the end disc portion Bd 5a in the design drawings is significantly smaller than the diameter of the recess Bd 6 relative to the outside diameter of end disc portion Bd 5 in Figures 5 and 8 of the utility application drawings.

Still further, there has been a change in the relative diameters of the end disc portion and the flashlight housing threaded portion. We have marked this threaded portion by the reference character Bd 8 in Figure 5 and 8 of Appendix I. In Figures 1 and 2 of Appendix II, we have marked the corresponding threaded portion by the reference character Bd 8a.

In Figures 5 and 8 of the utility application drawings (Appendix I) the outer diameter of the end disc portion Bd 5 is shown to be substantially the same as the pitch or maximum diameter of the threaded portion Bd 8. In contrast to this configuration, the end disc portion Bd 5a in Figures 1 and 2 of the design application drawings (Appendix II) has been made significantly smaller than the pitch or maximum diameter of the threaded portion Bd 8a.

In addition to the foregoing differences, there is yet another difference between the flashlight housing end wall configuration in the pending design application drawings and the original utility patent application drawings. In this regard, a beveled or conically shaped intermediate portion (which we have marked by the reference character Bd 9 in Figures 1 and 2 of Appendix II) has been added between the threaded portion Bd 8a and the end disc portion Bd 5a. No such beveled or conical portion is found in the utility application drawings.

In addition to the foregoing differences, there is a distinct difference between the textured mesh or net-like patterns of the central barrel portions shown in the pending design application drawings (Appendix II) and the original utility application drawings (Appendix I). We have marked this pattern by the reference character Bd 9 in Figures 1 and 2 of Appendix II. In Appendix I (the utility patent application drawings), we have marked the barrel pattern by the reference character Bd 10.

As compared with the extremely fine mesh or net-like textured pattern Bd 9 in the pending design application drawings, the mesh or net-like pattern Bd 10 as shown in Figure 8 of the utility patent application drawings is much more coarsely textured having significantly larger interstices and thus providing a distinctly different appearance as compared with the pattern in Figures 1 and 2 of the pending design application drawings.

Because of the distinctive differences between the original utility patent application drawings (Appendix I) and the pending design application drawings (Appendix II), we cannot agree that the original drawings in the '032 utility patent application contain illustrations depicting the illustrated ornamental design claimed in the instant design application. The distinctive design features found in the pending design

application drawings (Appendix II) and not in the original utility application drawings (Appendix I) cannot be dismissed as mere draftsman's errors or imperfections. Nor are they of an inadvertent or accidental nature. Instead, they are deliberate changes intentionally made in the design application drawings.

As stated in In re Salmon, supra, the determination as to whether differences in designs are sufficiently significant to produce different designs is largely a matter of aesthetics. In the present case, the distinguishing features between the design in the pending design application drawings and the design in the original utility application drawings are significant and produce a distinct difference in appearance. The instant design application drawings therefore fail to comply with the description requirement in the first paragraph of § 112. As a result, appellant's instant design application is not entitled under 35 USC 120 to the benefit of the filing date of his prior '032 utility application or to the filing date of any of the other utility applications in the chain of utility applications.

We will therefore affirm the examiner's § 103 rejection based on the Maglica and Huang patents, because, on the record before us, these references do qualify as prior art under § 102. However, because our reasons supporting the rejection go beyond the examiner's position, we hereby designate our affirmance of

the examiner's rejection as a new ground of rejection under 37 CFR 1.196(b).

In affirming the examiner's rejection, we are not unmindful of counsel's remarks about commercial success as set forth in the main brief and also in the paper entitled "Statement re Secondary Considerations" filed May 15, 1992. However, there is no competent evidence before us in the form of declarations or affidavits to support any of these contentions. Furthermore, quotations such as those appearing on page 3 of the main brief are in the form of hearsay and therefore are entitled to little if any weight. See In re Mageli, supra.

In addition, no nexus has been established between the merits of the claimed design and the commercial success as required, for example, in Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). If anything in the record before us can be considered as evidence, it certainly does not outweigh the evidence of obviousness when all of the evidence is considered as required in In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). The examiner's showing of obviousness based on the Maglica and Huang patents therefore stands unrebuted on the record before us.³

³ We are at a lost to understand why the examiner continues to rely upon these references when it appears that the design of appellant's commercial flashlight, which also constitutes prior (continued...)

Turning now to the examiner's rejection of the appealed claim under § 112 ¶ 1, we presume the examiner considers appellant's pending design claim to be based upon a disclosure which, as originally filed in the instant application, does not satisfy the description requirement in that paragraph. In other words, the disclosure as originally filed in the instant application lacks support for the presently claimed design.

In support of her position, the examiner sets forth two basic differences on page 4 of the answer. The first relates to the extent to which the flashlight bulb 45 can be seen. The second relates to the proportions of the threaded and end disc portions of the flashlight housing adjacent to the flashlight bulb 45.

We have carefully considered the issues raised by the examiner's § 112 ¶ 1 rejection together with the examiner's remarks and appellant's arguments. As a result, we conclude that the § 112 rejection is sustainable. Our reasons for this conclusion follow.

In a design application, it is clear that an amendment to the drawings is an amendment to the claim. Ex parte Hanback, 231 USPQ 739 (BPAI 1986). Therefore, a comparison is required

³(...continued)
art, most likely more closely resembles the presently claimed design.

between the presently pending design drawings in the instant application (see our Appendix II) and the disclosure as originally filed in the instant application, including the original design drawings (see our Appendix III) and the original specification as filed in the instant application. The differences to be discerned from this comparison is facilitated somewhat in view of the fact that the flashlight design shown in the drawings originally filed in the instant application closely corresponds to the configuration shown in Figure 8 of appellant's '032 patent application drawings.

In our Appendix III, we have marked the flashlight bulb by the reference numeral 45, the flashlight housing end disc portion by the reference character Bd 5b, the central shallow recess in end disc portion Bd 5b by the reference character Bd 6b, the recess bottom wall by the reference character Bd 7b, the adjacent threaded portion by the reference character Bd 8b and the mesh or net-like textured barrel portion by the reference character Bd 10b. In addition, we have retained the examiner's reference characters A and B in our Appendix III.

As is evident from the original drawing in our Appendix III, that the central shallow recess Bd 6b in the end disc portion Bd 5b closely corresponds to the central shallow recess Bd 6 in the original utility application drawings (see our Appendix I) in that the lower end of the bulb can be seen where

it meets or seats on the bottom wall of the recess. In contrast, the pending design drawings differ from the original filed design drawings in that the bottom end of the flashlight bulb 45 cannot be seen in the pending design drawings as pointed out by the examiner in paragraph (a) on page 4 of the answer. In fact, the appearance of the end disc portion Bd 5a differs from the end disc portion Bd 5b in the same respects that the end disc portion Bd 5a differs from the end disc portion Bd 5 as discussed supra in our review of the issues raised under § 120. Furthermore, the outside diameter of the end disc portion Bd 5b in our Appendix III is closely equal to the pitch or maximum diameter of the threaded portion Bd 8b whereas the outside diameter of the end disc portion Bd 5a in the pending design drawings (our Appendix II) has been made significantly smaller than the pitch or maximum diameter of the threaded portion Bd 8a. In addition, the conical or beveled flashlight housing portion Bd 9 has been added to the pending drawings. Both of these differences have been discussed supra with regard to our comparison of the pending design drawings with the original utility application drawings.

We also agree with the examiner that as compared with the threaded portion Bd 8b in the originally filed design drawings (our Appendix III), the proportions of the threaded portion Bd 8a have been changed in that the length and diameter of the threaded portion Bd 8a has been altered.

In addition to the foregoing, the mesh or net-like textured barrel pattern Bd 9 differs from the mesh barrel pattern Bd 10b for the reasons discussed supra in our comparison of the barrel patterns Bd 9 and Bd 10.

In traversing the examiner's § 112 ¶ 1 rejection, appellant seems to take the position that the test for compliance with the description requirement in the first paragraph of § 112 is that the additional or amended drawings need only be reasonably supported by the original disclosure. As support for this proposition, appellant cites no legal authority, but instead relies merely upon MPEP § 1504⁴ which reads as follows:

In design patent applications, as in applications filed under 35 U.S.C. 101, additional or amended illustrations involving new matter is in violation of 35 U.S.C. 132; 37 CFR 1.118. In a design patent application erasure of portions of the original disclosure may constitute new matter. In general terms, if the additional or amended illustration is reasonably supported by the original disclosure under 35 U.S.C. 112, first and second paragraphs, it will not be refused entry. Any entered amendment of the claim involving new matter will result in a new rejection based on 35 U.S.C. 112, first paragraph. [citations omitted]

Contrary to appellant's position, the test for compliance with the description requirement in the first

⁴ This section of the MPEP has been incorrectly identified in appellant's main brief as § 1505.

paragraph of § 112 is not whether the additional or amended disclosure (in this instance the design drawing) is "reasonably supported" by the original disclosure. Instead, the general test is whether the applicant had possession, as of the filing date of his application, of the specific subject matter now claimed by him. See In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). See also In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

With particular regard to design applications, the question is whether the designs are the same or different. In re Salmon, supra. The determination of whether particular differences in designs are sufficiently significant to produce different designs is said by the Salmon court to be largely a matter of aesthetics.

Thus, MPEP § 1504 does not set forth the test for compliance with the description requirement in the first paragraph of § 112. Instead, MPEP § 1504 merely sets forth a procedure which was followed by examiners prior to Ex parte Hanback, supra, for determining in the first instance whether additional or amended illustrations should be entered in a design application.

According to this guideline as set forth in the MPEP, the examiner would refuse entry of the additional or amended illustration if it was not reasonably supported by the original

disclosure. This guideline for determining in the first instance whether the amended or additional illustrations should be entered is no longer valid in view of Ex parte Hanback, supra. According to Hanback, any additional or amended drawing or illustration filed prior to a final Office action in a design application must be entered as a matter of right even though it is not reasonably supported by the original disclosure. It is to be noted, additionally, that the MPEP is not legal precedent in itself. Instead, it is merely a looseleaf training and instruction manual for examiners. See Racing Strollers Inc. v. TRI Industries Inc., supra.

Applying the proper test for compliance with the description requirement in § 112 ¶ 1, it is clear from the substantial differences discussed supra that the design now claimed is distinctly different from the design shown and described in the application as originally filed. Suffice it to say that no portion of the design is inconsequential or unimportant because a design is a unitary thing in which all of its portions are claimed and hence are material and contribute to the appearance of what constitutes the design. See In re Blum, 374 F.2d 904, 153 USPQ 177 (CCPA 1967).

In view of the foregoing, we will sustain the examiner's rejection of the appealed claim under the first paragraph of § 112. However, since our reasons supporting the

rejection go beyond the examiner's position, we will also designate our affirmance of the examiner's rejection under § 112 ¶ 1 as a new ground of rejection under 37 CFR 1.196(b).

The decision of the examiner rejecting the appealed claim under 35 USC §§ 103 and 112 is affirmed.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 USC 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to

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us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

AFFIRMED

37 CFR 1.196(b)


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